

REMARKS

Without acquiescing to the propriety of the rejections in the Office Action dated July 24, 2007, claim 1 has been amended. Entry of these amendments, reconsideration of the present patent application, and allowance of all claims pending herein are respectfully requested in view of the remarks below. Claims 1-10, 14, 15, and 17-20 are now pending.

Initially, applicant gratefully acknowledges the allowance of claims 9, 17 and 18, along with the conditional allowance of claims 4, 6, 8 upon them being rewritten into independent form to include all of the limitations of the base claim and any intervening claims. Applicant respectfully defers rewriting the claims as suggested in view of the remarks below.

§ 103 Rejections:

Claims 1, 3, 5, 7, 10, 14, 15, 19 and 20 stand rejected under 25 U.S.C. § 103(a) as being obvious over European Patent Application Publication No. EP 0480199 (EP '199) in view of U.S. Patent No. 4,318,953 to Smith et al. (Smith et al.).

Applicant notes that all of the features of claim 1 prior to the present response are not alleged to be present in the proposed combination of references on page 2-3 of the Office Action. In particular, there is no allegation of the proposed combination disclosing, teaching or suggesting an adhesive layer "remaining continuously repositionable". Applicant has attempted below to address the issues raised in the Office Action. However, if the below arguments and amendments do not put the application in condition for allowance, applicant respectfully requests that the present Office Action be corrected and that a new period for reply be provided to applicant according to MPEP § 710.06.

The Office Action alleges that the disclosure of a scrim being embedded in a base film layer as in EP '199 may be equated to the recitation of a textile layer into impregnation layers in claim 1. The material in the European reference is also alleged to include a pressure sensitive adhesive layer and release liner that is joined to the scrim layer. EP '199 is alleged to disclose all the elements of claim 1 except for the teaching that a printable varnish layer is deposited onto one of the impregnation layers. Smith et al. is alleged to disclose transfer material for use in a sign making machine. It is alleged that it would have been obvious to one of ordinary skill in the

art to use a lacquer disclosed in Smith et al. on the adhesive sheet material of EP '199 motivated by a desire to create a material that has a pleasing appearance and increased durability.

EP '199 discloses an adhesive sheet material for sign making which includes a carrier tape, a release liner and a sign tape between the carrier tape and release liner. As described in column 3, an adhesive sheet includes carrier layer 11 having a layer of adhesive 12 on a bottom surface, a base layer 13, a layer of scrim 14 joined to layer 13, pressure sensitive adhesive 15 on the opposite surface of scrim 14, and a release liner 16 covering adhesive layer 15. Carrier layer 11 is a layer of flexible material used to transfer a sign formed from layer 13. Adhesive layer 12 is a layer of low tack pressure sensitive adhesive coated onto the underside of carrier layer 11. Base layer 13 is a layer of plastic film or paper suitable for cutting into a sign. Scrim layer 14 is a layer of non-woven material joined to the surface of layer 13 opposite from the carrier layer. Pressure sensitive adhesive layer 15 is joined to scrim layer 14. Adhesive layer 15 is utilized to adhere a sign cut from base layer 13 onto a selected surface. Pressure sensitive adhesive layer 15 is aggressively and permanently tacky at room temperature and utilized to firmly adhere to a variety of dissimilar surfaces upon contact with only finger or hand pressure as described in column 5. Base layer 13, scrim layer 14, and pressure sensitive adhesive layer 15 are combined to form a sign tape 21 as described in lines 44-47 of column 5.

The Office Action alleges a pressure sensitive adhesive layer disclosed in column 5, lines 7-21 discloses the pressure sensitive adhesive layer recited in claim 1. As indicated above, adhesive layer 15 of EP '199 is aggressively and permanently tacky at room temperature and thus cannot remain continuously repositionable in contrast to the adhesive layer recited in claim 1. As also indicated above, the Office Action alleges that all the features of claim 1 except for a printable varnish layer deposited onto one of the impregnation layers is taught by EP '199. Accordingly, for at least the reason that there is no repositionable pressure-sensitive adhesive layer deposited onto an impregnation layer wherein the adhesive layer remains continuously repositionable disclosed in EP '199, the proposed combination cannot make claim 1 of the present application obvious.

As indicated above, Smith et al. is alleged to disclose a printable varnish layer deposited onto an impregnation layer, because this feature is acknowledged in the Office Action as not being taught by EP '199. Smith et al. discloses transfer materials which include a carrier sheet

having indicia thereon, which is usually formed by printing from a printing ink composition and adhesive over the indicia. Column 6, lines 50-62 disclose a PVC sheet bearing letters which are sprayed with black cellulose lacquer and air dried. It is presumed that the lacquer is intended to protect the letters applied to the PVC sheet.

The Office Action alleges that it would have been obvious to use the lacquer of Smith et al. on the adhesive sheet material of EP '199, but it is unclear which portion of the adhesive sheet material 10 the lacquer is intended to be applied to. Further, it is unclear what the motivation to add the lacquer thereto would be despite the allegation in the Office Action that it would be motivated by the desire to create a material that has a pleasing appearance and increased durability. As described above, a sign is cut from base layer 13 and applied utilizing adhesive layer 15. Unlike the letters in Smith et al., the lettering is not transferred from one material to another and instead the letters are cut from a base layer. There is no reason to add a lacquer to prevent the degradation of the ink applied to a PVC layer as in Smith et al. and instead the letters cut from base layer 13 would not need an additional lacquer layer applied thereto. As indicated above, adhesive layer 15 is aggressively and permanently tacky and would clearly hold the base layer in its intended location. Moreover, the varnish layer recited in claim 1 is a printable varnish layer which contrasts with the cut out letters of EP '199 and the transfer of lettering to PVC material disclosed in Smith et al., neither of which would be printable.

Thus, there would be no reason to combine the references as proposed and if the references were combined they would not teach all the elements of claim 1 of the present application. For example, no repositionable pressure-sensitive adhesive layer nor a printable varnish layer are disclosed in either of the references or their combination. Instead, the proposed combination is a mere hindsight acknowledgement of the features of claim 1 of the present application and such hindsight reconstruction is improper. Accordingly, because the proposed combination cannot make claim 1 of the present application obvious, this claim is believed to be allowable along with the dependent claims, which are believed to be allowable for at least the same reasons and for their own additional features.

Further, as indicated above, the Office Action notes that the Examiner equates disclosure in EP '199 of a scrim being embedded in a base film layer to applicant's textile layer and two impregnation layers. There is no justification in the Office Action for the Examiner's assertion

that the noted features recited in claim 1 are equivalent to those cited in EP '199. A mere assertion of the equivalents in the Office Action is not sufficient. Thus, the lack of a teaching of the textile layer and two impregnation layers provides an additional reason why claim 1 cannot be obvious over the proposed combination.

Claims 5 and 10 stand rejected over EP '199 and Smith et al. because although these references do not explicitly teach the claimed adhesive force it is allegedly reasonable to presume that this property is inherent in the invention of Gray et al, Crouch et. Al, and Paquette et al. As indicated in previous Office Action Responses, the cited references do not disclose, teach or suggest a repositionable pressure sensitive adhesive layer for securing to a display zone, and thus the cited references cannot teach, suggest, or disclose the features of claims 5 and 10 of the present application and these claims are believed to be allowable.

CONCLUSION

It is believed that the application is in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Examiner is invited to telephone the undersigned attorney at the telephone number provided.

Respectfully submitted,

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